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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,224	06/22/2000	Jorma Jaakkola	# 2132-34PCON	7789

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EXAMINER

ORTIZ, XIOMARA Y

ART UNIT	PAPER NUMBER
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2141

10

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,224

Applicant(s)

JAAKKOLA ET AL.

Examiner

Xiomara Y. Ortiz

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is in response to the Amendment dated 02 January 2004.
2. Claims 19-35 are pending in the application.

Specification

3. Previous objection to the specifications has been overcome with the corrections included in Amendment A.

Drawings

4. Previous objection to the drawings has been overcome with the correction to the specification included in Amendment A.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 19-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Szviatovszki et al, U.S. Patent No.6,470,010 B1.

Regarding claim 19, Szviatovszki discloses method and systems for setting up a speech connection in different networks that comprises:

- a.) means for linking the system, in a transparent manner with respect to telecommunication network architecture of the first and second telecommunication networks, to telecommunication network elements of the first and second telecommunication networks handling subscriber data, (fig.1 for linking two networks ISDN and data network and col.6 64-67 – col.7 lines 1-5 for transparency);
- b.) means for storing the subscriber data of the first and second telecommunication networks in a single logical subscriber database, (database col.3 lines 20-24, col.4 lines 22-67, and datapoint col.5 lines 1-30 and col.5 60-65); and
- c.) means for exchanging subscriber data between the telecommunication network elements handling subscriber data and the subscriber database, (col.5 lines 1-30 for place subscriber data (subscriber location, personal identifier, etc.) in the database).

Regarding claim 20, Szviatovszki discloses all the limitations in claim 19 and also discloses means for transmission of signaling between the first and second telecommunication networks, (col.1 5-18 for speech connection between two telecommunication networks and col.2 lines 57-67 – col.3 lines 1-11).

Regarding claim 21 and 22, Szviatovszki discloses all the limitations in claims 19 and 20, and also discloses means for converting data types between each of the first and second telecommunication networks and the subscriber database, (col.4 lines 22-67 for a gateway receiving ATM-network internet-address and convert it into a decimal code ISDN- address and it transmit the converted address to be recorded in the database).

Regarding claim 23, Szviatovszki discloses all the limitations in claim 19, and also discloses means for forming a service profile for a subscriber of one of the first and second telecommunication networks, (fig.4 "store profile to the user").

Regarding claim 24, Szviatovszki discloses all the limitations in claim 19, and also discloses a system said storing means is a part of a network element of at least one of the first and second telecommunication networks, (col.1 lines 9-22 for network architecture called intelligent network applied in most telecommunication network as PSTN, ISDN, etc. fig. 1 for service datapoint (database) in the intelligent network).

Regarding claim 25, Szviatovszki discloses all the limitations in claim 19, and also discloses a system wherein at least one of the first and second telecommunication networks includes a terminal device for use by a network subscriber to establish a telecommunication connection, said system being implemented in the terminal device, (fig.1 phone 6 and Pc or workstation 5).

Regarding claims 26-30 and correspond to the methods of the system in claims 19-23. Therefore, these claims are rejected under the same basis.

Regarding claim 31, Szviatovszki discloses all the limitations in claim 26, and also discloses a method establishing a connection is performed utilizing existing elements of the first

and second telecommunication networks, (fig.1 for workstations and telephone elements to establish communication and col.6 lines 15-41).

Regarding claim 32 and 33, Szviatovszki discloses all the limitations in claim 19 and 26, and also discloses a system and methods wherein said first and second duplex telecommunication networks are a digital multi-service network (ISDN) and an Internet Protocol (data networks), (fig.1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over David Szviatovszki, U.S. Patent No.6,470,010 B1.

Regarding claim 34 and 35, Szviatovszki discloses all the limitations in claim 19 and 26, but do not explicitly teach that the system operates in real-time. However Szviatovszki discloses a user, sending at the same time his current data network address, personal identifier, transmitted to the gateway connecting the data network and the ISDN-net (col.3 lines 12-19), methods and systems for setting up a speech connection in different networks (title), and also discloses that the objective of such inventions is to provide a mechanism that permits a subscriber to call any number from a telephone connected to a data network (col.2 lines 50-55). Therefore, it would

have been obvious to one ordinary skilled in the art to be in real-time, since Szviatovszki teaches immediate (at the same time) transfer of information when setting up a speech connection, and calling to a telephone to in a data network. It is well known that telephone conversations are in real time because conversations are happening at the same moment.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xiomara Y. Ortiz whose telephone number is (703) 305-6783. The examiner can normally be reached on Monday-Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Xiomara Y. Ortiz
Patent Examiner
Art Unit 2141


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER